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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dan Kikinis

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EXAMINER

SALCE, JASON P

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/875,546	<b>Applicant(s)</b> KIKINIS, DAN	
	<b>Examiner</b> Jason P. Salce	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9,12-15,17,20-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9,12-15,17,20-23 and 25-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 4/7/2008 have been fully considered but they are not persuasive.

Applicant has amended claim 1 to overcome the previous rejection of record and argued the limitations of the remaining claims, however, based on the Applicant's arguments, Applicant has presented the same issue previously addressed. Therefore the examiner will repeat the 112 1<sup>st</sup> Paragraph rejection below, as well as further present the rebuttal to the Applicant's arguments regarding this issue.

Applicant had previously argued that the specification teaches the concurrent display (on the second display of the computing device) of any portion of an EPG on the receiving system's video display. Applicant specifically directs the examiner's attention to Paragraph 0008, which states that the EPG may be displayed on a display screen coupled to a computing device and additionally, the user may still display the EPG on the primary display if they so wish, however, Paragraph 0008 makes no such statement as to the display of the EPG on both devices **concurrently**. The Applicant states, "The ability of the user to still display the EPG on the primary display if they so wish specifies that the EPG on the computing device and on the video display **may be concurrently displayed**". The examiner notes that the mere teaching of two video displays would provide the ability for the EPG to **may be** concurrently displayed, however, in order to

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claim such a feature, the specification must explicitly teach the concurrent display of an EPG on both devices.

The examiner agrees that Nelson does not teach the claim limitations currently presented, however, neither does Applicant's specification, which is why the 112 1<sup>st</sup> Paragraph rejection was previously made and has again been presented herein.

The examiner further notes that even if the specification supported the claim limitations currently presented to the examiner, an updated search has resulted in the discovery of the Grooters prior art reference (U.S. Patent No. 6,862,741), which clearly reads on the amended claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-7, 9, 12-15, 17, 20-23 and 25-33 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The independent claims to state, “display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG”. The examiner further notes that the later claims further recite displaying an EPG simultaneously on both displays, but specifically specifies what portions of the EPG are displayed.

The examiner notes that although Paragraph 0033 of the instant application states, “**A user of the EPG displayed on computing device 105 may also, through input device 160, display portions of or the entire EPG on video display 105**”, this portion of the specification fails to specifically state that EPG is displayed concurrently on the computing device and the video display. Further note the arguments above for Paragraph 0008 further failing to teach the concurrent display limitations.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17, 20-23, 27, 30 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The examiner notes that the claims recite a machine-readable medium that contain “instructions”. The specification at the bottom of Paragraph 0039 states that the instructions can be downloaded, which would include that the machine-readable

medium is the carrier signal used to carry the downloadable instructions. Signal claims have been deemed non-statutory subject matter (see MPEP § 2106).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 7, 9, 12, 15, 17, 20, 23 and 25-33 are rejected under 35

U.S.C. 102(e) as being clearly anticipated by Grooters (U.S. Patent No. 6,862,741).

Referring to claim 1, Grooters discloses a video display configured to communication with a receiving system (**see Figure 3 and Column 6, Lines 26-35 for display 226 communicating with information handling system 100**) and to display a video broadcast (**see Column 6, Lines 26-35 for displaying a television program on display 226**).

Grooters also discloses a computing device configured to communication with the receiving system (**see handheld device 228 connected to information handling system 100 in Figure 3**), the computing device having a second display configured to

concurrently display an Electronic Programming Guide (EPG) corresponding to the video broadcast (**see Figure 3 and Column 6, Lines 13-19**).

Grooters also discloses that the computing device is configured to display at least a portion of the EPG on the second display while the video display is concurrently displaying at least a portion of the EPG (**see Column 7, Lines 24-36 and claim 1 for highlighting a program guide entry on a first display and transmitting and displaying additional program guide information on a second display**).

Referring to claim 4, Grooters discloses that the computing device is a wireless device (**see RF/IR Transceiver Services 220 in Figure 2**).

Referring to claim 7, Grooters discloses that the video display is a display of a television system (**see Column 1, Lines 23-26 and Column 6, Lines 26-36 for displaying a television program on a television display**).

Referring to claims 9, 12 and 15, see the rejection of claims 1, 4 and 7, respectively.

Referring to claims 17, 20 and 23, see the rejection of claims 1, 4 and 7, respectively.

Referring to claims 25-27, see the rejection of claim 1 for displaying an EPG on both displays (**further note Column 5, Line 43 through Column 8, Line 20 for displaying different portions on each display**).

Referring to claims 28-30, Grooters discloses that the computing device is configured to transmit a signal to the receiving system corresponding to an instruction to display at least a portion of the EPG on the video display concurrently while at least a portion of the EPG is displayed on the second display (**further note Column 5, Line 43 through Column 8, Line 20 for displaying different portions on each display**).

Referring to claims 31-33, see the rejection of claim 1 for display an EPG on both displays (**further note Column 5, Line 43 through Column 8, Line 20 for displaying different portions on each display**).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Claims 5-6, 13-14 and 21-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Grooters (U.S. Patent No. 6,862,741) in view of Ellis et al. (U.S. Patent No. 6,774,926).

Referring to claims 5-6, Nelson discloses all of the limitations in claim 1, but fail to teach that the computing device is a PDA or web phone.

Ellis discloses that a computing device can be a PDA or web phone (**see Column 6, Lines 23-27 and Lines 66-67 and Column 8, Lines 59-64**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the computing device, as taught by Grooters, using the PDA or web phone, as taught by Ellis, for the purpose of taking advantage of using devices that the viewer/user already owns to perform the various television control functionality.

Referring to claims 13-14, see the rejection of claims 5-6, respectively.

Referring to claims 21-22, see the rejection of claims 5-6, respectively.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2623

Jason P Salce  
Primary Examiner  
Art Unit 2623

June 25, 2008